## REMARKS

The Office Action of September 24, 2009 and the references cited therein have been carefully studied. Favorable reconsideration and allowance of the claims are requested.

### I. Claim Status and Amendments

Claims 43-47 presently appear in this case and stand rejected. No claims have been allowed.

Applicants appreciate the examiner's withdrawal of the species requirement.

By way of the present amendment, claim 1 has been amended to remove the "preventing" and "inflammation" language. Claim 44 has been amended to better conform to US practice for antecedent basis. Support can be found in the claim as filed. Claim 45 is amended to include a period at the end of the claim to provide proper punctuation. No matter has been added.

The claims define patentable subject matter warranting their allowance for the reasons discussed herein.

### II. Foreign Priority

Acknowledgment by the PTO of the receipt of Applicants' priority papers filed under Section 119 is noted.

## III. Enablement Rejection

Claims 43-47 have been rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement for the reasons set forth on pages 2-5 of the Office Action. The examiner states that the application is enabling for the method treatment of pain or inflammation but not for preventing.

For the sole purpose of expediting prosecution and not to acquiesce to the rejection, the claims have been amended to remove the "preventing" language, thereby obviating the rejection. Withdrawal of the rejection is requested.

## IV. Anticipation Rejection

Claims 43-47 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Hu (US 5,627,195) for the reasons set forth on page 5 of the Office Action. This rejection is respectfully traversed.

Independent claim 43, as amended, is drawn to a method of treating pain, comprising administering to a patient in need thereof, as an effective ingredient, a benzylisoquinoline derivative represented by general formula (I), a bisbenzylisoquinoline derivative represented by general formula (II), or a pharmaceutically acceptable salt thereof. Applicants respectfully submit that Hu does not disclose a method for treating pain by itself. Instead, the cited patent relates to

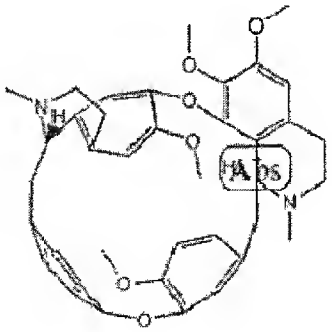
treating ocular inflammation associated with keratitis or conjunctivitis by administering to the subject a tetrandrine or a tetrandrine agonist.

Further, though neferin is mentioned in a list of compounds as being one example of a tetrandrine agonist, neferin is mentioned in name only and there is no example of administering neferin in any method, let alone one for treating pain. Nor is there any experimental data for neferin. Instead, it is only tetrandrine as such whose effect is confirmed by experimental data in Hu, but again this is for treating ocular inflammation, not pain. Also, there is no disclosure as to whether neferin would be effective to treat pain at all. Likewise, there is no disclosure of an effective dosage of neferin for treating pain. Accordingly, Applicants respectfully submit that there is no disclosure for ascertaining what would be an effective amount of neferin to treat pain by itself.

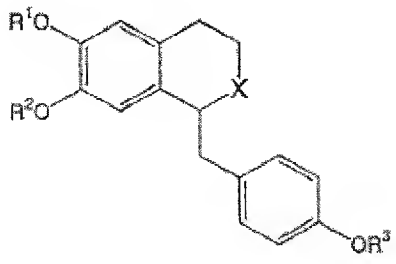
For these reasons, Applicants respectfully submit that Hu is a non-enabling reference for administering an effective of amount of neferin for treating pain. It is well established that "[i]n determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an

assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). As there is no recognition of an effective amount of neferin for treating any condition let alone pain, it is believed that Hu is a non-enabling reference.

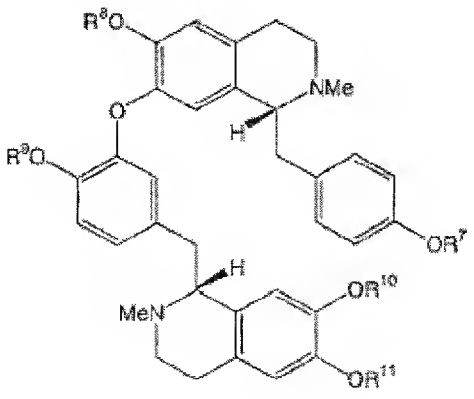
In addition, tetrandrine compound disclosed in Hu clearly differs in chemical structure, including backbone, as well as functional groups from the compound of the claimed method. This is clear by comparing the chemical structure of the tetrandine with the claimed compounds, as shown herein. The chemical structure of tetrandrine (6,6',7,12-tetramethoxy-2,2'-dimethylberbamains) is:



By contrast, the chemical structure of the compound of a benzylisoquinoline derivative represented by general formula (I) of claim 43 is as follows:




wherein $R^1$, $R^2$ and $R^3$ each independently represent a hydrogen atom, a $C_{1-6}$ alkyl group which may be substituted, an aryl group which may be substituted or a heteroaryl group which may be substituted, and X represents $NR^4$ or $N^+R^5R^6Y$ in which $R^4$ represents a hydrogen atom or a $C_{1-6}$ alkyl group, $R^5$ and $R^6$ each independently represent a hydrogen atom or a $C_{1-6}$ alkyl group, and Y represents a halide, hydroxide, or sulfate ion. Similarly, the chemical structure of the compound of a bisbenzylisoquinoline derivative represented by general formula (II) of claim 43 is as follows:




wherein $R^7$, $R^8$, $R^9$, $R^{10}$ and $R^{11}$ each independently represent a hydrogen atom, a $C_{1-6}$ alkyl group which may be substituted, an

aryl group which may be substituted or a heteroaryl group which may be substituted.

As can be seen, the chemical structure of the tetrandrine compound of Hu clearly differs from that of the compounds of the claims. Thus, the tetrandine compounds disclosed in Hu are clearly different from the compounds utilized in the claimed method. Also, as discussed above, the claimed method is for treating pain (as described in Examples 9-14 of the original specification), whereas the method disclosed in Hu is for treating ocular inflammation associated with keratitis or conjunctivitis. Applicants respectfully submit that Hu does not disclose a method for treating pain in general.

In sum, the claimed method of the present application relates to a method for treating pain by administering a benzylisoquinoline derivative or bisbenzylisoquinolin derivative having the defined chemical structure as represented by formula (I) or formula (II). Applicants respectfully submit that Hu does not teach this method, since it involves the use of a different compound for treating ocular inflammation and not pain.

Therefore, Applicants believe that the method of the instant application is not anticipated by Hu. For these reasons, main claim 43 and all claims dependent (i.e., claims 44-47) thereon are believed to be novel over Hu. Withdrawal of the rejection is requested.

In addition, it should be noted that Hu does not disclose the features of dependent claims 46 and 47. Hu does not teach a method of treating pain by administering the compound orally as part of a health food (claim 46) or a beverage (claim 47), containing the compound. For these additional reasons, dependent claims 46 and 47 are believed to be novel over Hu.

In view of the above, withdrawal of the anticipation rejection over Hu is requested.

## V. Conclusion

Having addressed all the outstanding issues, this paper is believed to be fully responsive to the Office Action. It is respectfully submitted that the claims are in condition for allowance, and favorable action thereon is requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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